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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,000	11/03/2005	Heinz Focke	048141.018US	9477
25461 7590 08/31/2009 SMITH, GAMBRELL & RUSSELL SUITE 3100, PROMENADE II 1230 PEACHTREE STREET, N.E. ATLANTA, GA 30309-3592				
EXAMINER STEPHENS III, JOSE S				
ART UNIT		PAPER NUMBER		
3728				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/521,000

Applicant(s)

FOCKE ET AL.

Examiner

JOSE S. STEPHENS III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2009.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-32 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 29-32 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 03 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. This Office Action acknowledges the applicant's amendment filed 4 March 2009. Claims 29-32 are pending in the application; and claims 1-28 have been canceled.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 29 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 29 recites the limitation "the oblique collar edge" in line 29. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Focke et al. (US Patent 6,742,651).

With respect to claim 29, figure 16 of Focke discloses a hinge-lid box (see figure 16) for cigarettes or cigarette packs, comprising a blank 81, the blank being a package blank made of thin cardboard (see column 2, lines 64-67) and having continuous regions for an outer box side tab 16 and a lid side tab 28, a box front wall 14 and a lid front wall 25, a box side wall 17 and a lid side wall 27, a box rear wall 15 and a lid rear wall (wall between lid rear wall 15 and lid top wall 33), and a marginal connective strip (see figure 16) for connecting the side tabs for forming a box part (see figure 16) with the box front wall, the box rear wall, the box side wall and a lid (combination of 25, 27, 28, 29, and 34) having lid front wall 25, lid rear wall (wall between lid rear wall 15 and lid top wall 33) and lid side walls 27, wherein during the production process a collar 13, which is connected as a single piece to one side of the package blank, and is folded against an inner side of the package blank (see column 5, lines 14-27), wherein the collar comprises a collar front wall 31 and lateral collar flaps (37 and 38), and further comprises an upper collar edge (edge above the collar front wall when folded) having oblique slopes (see edges above lateral collar flaps when folded) along upper edges of the collar flaps; the package blank further comprises a

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punched line (lines between the lid inner tab and the box front wall) for delimiting the lid front wall, the lid side tab and the lid side wall from adjacent regions of the box part, with the punched line forming an oblique leg for delimiting the box side tab from the lid side tab (see figure 16); a lid strip (upper portion of the box strip above the lateral cutout 82) is laterally attached to the lid rear wall and a box strip 23 is laterally attached to the box rear wall, the lid strip being a continuation of the box strip, and the lid strip being for connecting to the lid side tab; and the box strip and the lid strip are delimited from one another by a cutout 82.

Focke does not disclose the box strip and the lid strip are delimited from one another by a wedge-shaped cutout to form oblique edges on the box strip and the lid strip; and the wedge-shapes cutout and the oblique edges form an angle that is greater than an angle formed in the region of pack sides and defined by the oblique collar edge and an oblique closing edge formed by a leg of the punched line, such that the oblique edges bordering the cutout are not visible.

However, to modify the shape of the cutout to a rectangular shaped cutout of Focke would have been obvious to one of ordinary skill in the art at the time the invention was made in order to save weight, material and money. The shape of the cutout has no criticality to the use of the strip. The purpose of the lid strip and the box strip are to attach them to the lid side tab and the box side tab while having no part of the strip visible after they are attached, and the shape of the cutout has no criticality with respect to that function. It was an obvious matter of design choice to make the shape of an object of whatever form or shape was expedient because a change in shape was recognized as being within the level

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of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

With respect to claim 30, Focke discloses the box strip 23 is arranged opposite to the box side tab 17 and the box strip is connected to the collar flaps 38 in the region of the collar and to the box side tab outside of the collar (see column 5, lines 14-27).

8. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Focke et al. (US Patent 6,742,651) in view of DeBlasio (US Patent 5,205,403).

With respect to claim 31, figure 16 of Focke discloses a hinged-lid box for cigarette packs (see figure 16), comprising a package blank 81 made of thin cardboard (see column 2, lines 64-67) for forming a box part, the box part having a box front wall 14, a box rear wall 15 and a box side wall 17, and a lid (combination of 25, 27, 28, 29, and 34), the lid having a lid front wall 25, a lid rear wall (wall between lid rear wall 15 and lid top wall 33) and lid side walls 27, with a collar 13 being arranged within the box part and abutting an inner side of the box front wall and of the box side walls (see column 5, lines 14-27), wherein

Focke does not disclose two of the boxes are joined together as sub-packages to form a multipack unit; the sub-packages lie with base walls of the sub-packages against one another, the base walls each being formed from a cover wall extending from box rear wall; the sub-packages of the multipack unit have a laterally reversed arrangement such that a front face, formed from the box front wall, of one of the sub-packages lies on the same side as a rear face,

formed from the box rear wall, of the other one of the sub-packages; and the sub-packages are connected detachably to one another.

Figure 4 of DeBlasio discloses two of the boxes (34 and 36) are joined together as sub-packages to form a multipack unit; the sub-packages lie with base walls of the sub-packages against one another, the base walls each being formed from a cover wall extending from box rear wall (see figure 4); the sub-packages of the multipack unit have a laterally reversed arrangement such that a front face (see figure 4), formed from the box front wall, of one of the sub-packages lies on the same side as a rear face (see figure 4), formed from the box rear wall, of the other one of the sub-packages; and the sub-packages are connected detachably to one another by a sticker 40.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to join two boxes of Focke together to form a multipack in order to form a multiple unit box of dimensions compatible with existing tax-stamping machinery common to distributors, without requiring customized tax-stamping machinery or hand stamping machinery, as taught by DeBlasio (see column 2, lines 59-65).

The combination of Focke and DeBlasio disclose the claimed invention except for the hinge-lid box has a height dimensioned to correspond approximately to the height of the cigarette packs; the hinge-lid box has a width dimensioned such that five of the cigarette packs can be accommodated next to each other within the hinge-lid box, with the five cigarette packs abutting each other in a large-surface front faces to rear faces relationship. It would have been

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an obvious matter of design choice to modify the dimensions of the boxes, since such a modification would have involved a mere change in the size of a component. A change in size is recognized as being within the level of ordinary skill in the art. In *Gardner v. TEC Systems, Inc.*, 220 USPQ 777 (Fed. Cir. 1884), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984).

9. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Focke et al. (US Patent 6,742,651) in view of DeBlasio (US Patent 5,205,403) as applied to claim 31 above, and further in view of Adams et al. (US Patent 5,141,106).

With respect to claim 32, the combination of Focke and DeBlasio disclose the sub-packages are connected to one another by at least one adhesive label (reference number 40 of DeBlasio) connecting opposing narrow side walls of the sub-packages (see figure 4 of DeBlasio), the narrow side walls being formed from the box side tab or the box side wall.

The combination of Focke and DeBlasio does not disclose the adhesive label having a perforation line in the plane of the abutting base walls of the sub-packages. Figure 3 of Adams discloses boxes (30 and 32) comprising adhesive label 40 having a perforation line 41 in the plane of the abutting base walls of the sub-packages. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the adhesive label of DeBlasio by incorporating a perforation line in the plane of the abutting base walls of the sub-packages in order to facilitate a clean separation of the two boxes, as taught by Adams (see column 4, lines 50-60).

Response to Arguments

10. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown are packages analogous to applicant's instant invention.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSE S. STEPHENS III whose telephone number is 571-270-3797. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ehud Gartenberg can be reached on 571-272-4828. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JSS

/Ehud Gartenberg/
Supervisory Patent Examiner, Art Unit 3728